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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YVON THEBERGE and EDWARD M. STOPPER

Appeal 2015-002110
Application 13/209,402
Technology Center 3700

Before ANNETTE R. REIMERS, JEFFREY A. STEPHENS, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Yvon Theberge and Edward M. Stopper (Appellants) appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject under 35 U.S.C. § 102(b) claim 11 as anticipated by Kondo (US 4,506,197; iss. Mar. 19, 1985) and to reject under 35 U.S.C. § 103(a): (1) claim 12 as unpatentable over Kondo and Garnier (US 4,609,155; iss. Sept. 2, 1986); (2) claims 13, 14, 16, and 17 as unpatentable over Kondo and Scuccato (US 2002/0175232 A1; pub. Nov. 28, 2002); and (3) claim 15 as unpatentable over Kondo, Scuccato, and Ferreira (US 5,609,053; iss. Mar. 11, 1997). Claims 1–10 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

The claimed subject matter relates to “computer readable instructions” for a mill. *See* Spec. Abstract, Figs. 1, 4, and 5.

Claim 11, the sole independent claim on appeal, is representative of the claimed subject matter and recites:

11. A non-transient computer readable medium for providing instructions for a mill, the non-transient computer readable medium comprising:
instructions to cease rotation of the mill during start up based upon sensed acceleration of rotation of the mill.

ANALYSIS

Anticipation by Kondo

Claim 11

The Examiner finds that column 7, lines 22–65 of Kondo “teaches stopping, Q(d) is the tension value control signal, based on drooping control the mill at sensed acceleration of rotation as the tension begins, when tension falls below value, Q(d) stops for a control method for a mill.” Final Act. 9; *see also id.* at 3.

At the outset, we agree with Appellants that the Examiner fails to address Appellants’ contentions in the Answer. *See* Reply Br. 2; *see also id.* at 3; Ans. 4–6; Appeal Br. 7–11. Specifically, the Examiner fails to address Appellants’ contention that Kondo fails to teach “the claim limitation[] requiring that rotation of the mill is ceased,” in particular that “[t]he stoppage of Q(d) in Kondo is not ceasing rotation of the mill.” *See* Reply

Br. 2; *see also id.* at 3; Ans. 4–6; Appeal Br. 7–11.

In this case, we agree with Appellants that output signal Qd of Kondo (1) “is a control signal which merely equalizes Qa and Qg to cancel a drooping characteristic Qc”; and (2) “is used by speed control circuit 27 to perform a control function of reversing a decrease in mill motor speed due to the drooping characteristic.” *See* Appeal Br. 7; *see also id.* at 8–11; Reply Br. 2–3; Kondo 7:27–29, 48–51. We further agree with Appellants that “‘stopping’ the signal Q(d) [of Kondo] does not result [in] rotation of the mill being stopped, but merely results in no further adjustments being made in the upward or downward direction of tension.” *See* Appeal Br. 11; *see also id.* at 7–10; Reply Br. 2–3; Kondo 7:52–59.

Accordingly, for the foregoing reasons, we do not sustain the Examiner’s rejection of independent claim 11 as anticipated by Kondo.

Obviousness Rejections

Claims 12–17

The Examiner’s obviousness rejections of claims 12–17 are each based on the same unsupported findings discussed above with respect to independent claim 11. *See* Final Act. 4–8. The Examiner does not rely on Garnier, Scuccato, or Ferreira to remedy the deficiencies of Kondo. Accordingly, for reasons similar to those discussed above for claim 11, we likewise do not sustain the Examiner’s obviousness rejections of claims 12–17.

New Ground of Rejection

Claims 11–17 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Supreme Court has set forth “a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1294 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to patent-ineligible concepts (i.e., laws of nature, natural phenomena, and abstract ideas). *Id.* If so, we must secondly “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* The Supreme Court characterizes the second step of the analysis as “a search for an ‘inventive concept’ — i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (alteration in original).

Independent claim 11 is directed to a non-transitory computer readable storage device having instructions for execution on such apparatus. In other words, independent claim 11 is directed to a set of rules performed by a computer (i.e., software).

Our reviewing court instructs us that “[s]oftware can make non-abstract improvements to computer technology just as hardware improvements can, and sometimes the improvements can be accomplished

through either route.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). We are further instructed that we must determine if “the claims are directed to an improvement to computer functionality versus being directed to an abstract idea, even at the first step of the *Alice* analysis.” *Id.* Here, the limitation at issue is not directed to an improvement of a computer’s functionality. Accordingly, independent claim 11 is directed to an abstract idea.

Having determined that independent claim 11 is directed to an abstract idea, we must determine whether the additional elements of the independent claim transform it into patent-eligible subject matter. Although independent claim 11 sets forth specific data to be collected and analyzed and indicates that an algorithm is to be used to manipulate the collected data, it does not specify how the collection is accomplished. An instruction to apply an abstract idea using some unspecified, generic equipment (in this case, computer software) “is not ‘enough’ to transform the abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2351 (citing *Mayo*, 132 S. Ct. at 1297). As such, independent claim 11 at most requires only a “mathematical algorithm[] to manipulate existing information to generate additional information.” *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014). Thus, the limitation of claim 11 does not transform the abstract idea embodied in the claim. Rather, it simply implements that idea.

Independent claim 11, when its limitations are considered “both individually and ‘as an ordered combination,’” amounts to nothing more than an attempt to patent the abstract ideas embodied in the step of the claim. *See Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298).

Accordingly, the limitation of independent claim 11 fails to transform the nature of the claim into patent-eligible subject matter. *See id.* (citing *Mayo*, 132 S. Ct. at 1297, 1298). The dependent claims do not transform the subject matter of independent claim 11 for similar reasons, and thus, are not directed to patent-eligible subject matter as well.

DECISION

We REVERSE the Examiner's decision to reject claims 11–17 under 35 U.S.C. §§ 102 and 103.

We enter a NEW GROUND OF REJECTION of claims 11–17 under 35 U.S.C. § 101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the Appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)